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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,183	05/23/2000	Paul Lapstun	NPK002US	9150

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

TRAN, TONGOC

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 09/29/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/575,183	LAPSTUN ET AL.	
	Examiner	Art Unit	
	Tongoc Tran	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/575,183.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicants' application serial no. 09/575,183 filed on 5/23/2000.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 8/7/2000 and 3/5/2001 has been considered.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Debry (U.S. Patent No. 6,314,521) hereinafter Debry ['521].

In respect to claim 1, Debry ['521] discloses "a network connected to a printer and a registration server, a network registration protocol for registering the printer on the network, including the steps of installing a secret unique identifier in the printer and in a database of the registration server, before the printer is connected to the network" (see col. 8, lines 56-64); "then, when the printer is connected to the network, authenticating the printer to the server by comparing the secret unique identifier installed in said printer and said server, using a secure transmission over said network" (see col. 8, line 65-col. 9, line 14).

6. In respect to claim 2, Debry ['521] discloses the network registration protocol according to claim 1, including the further step of "holding said secret unique identifier in non-volatile memory in said printer together with a public unique identifier" (see col. 8, lines 56-64, model number and serial number).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Debry (U.S. Patent No. 6,314,521) hereinafter Debry ['521] in view of Debry (U.S. Patent No. 385,728) hereinafter Debry ['728].

9. In respect to claim 8, Debry ['521] discloses "a network registration signal for transmission over a network from a printer to a remote registration server to register the printer with the server, where the signal is transmitted at the first occasion the printer is connected to the network, and includes: a secret unique identifier and a public unique identifier retrieved from non-volatile memory in the printer and a public key which is created, together with a paired secret key, in the printer" (see col. 8, lines 56-64), "so that upon receipt of the signal at the registration server the secret unique identifier and public unique identifier are tested to verify the identifier of the printer and, in the event the printer's identity is verified, a certificate is created and signed which contains the printer's public unique identifier and a public signature key" (see col. 8, line 65-col. 9, line 14).

Debry ['521] does not explicitly disclose said printer create a public key together with a paired secret key. However, Debry ['728] discloses an encryption key can be generated in a printer (see col. 10, lines 12-19). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement of the teaching of Debry ['728] to generate key in the printer instead of generate the key by the printer's manufacture as taught by Debry ['521] for better protection of the key from the third party like the manufacture of the device.

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10. In respect to claim 3, Debry ['521] discloses the network registration protocol according to claim 2, including the further step of "creating a public key together with its paired private key in said printer". However, Debry ['728] discloses an encryption key can be generated in a printer (see col. 10, lines 12-19). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement of the teaching of Debry ['728] to generate key in the printer instead of generate the key by the printer's manufacture as taught by Debry ['521] for better protection of the key from the third party like the manufacture of the device.

11. In respect to claim 4, Debry ['521] and Debry ['728] disclose the network registration protocol according to claim 3, Debry ['521] further discloses the step of, "at said time the printer is connected to the network, transmitting the secret unique identifier, the public unique identifier over the network to the registration server using said secure transmission (see col. 8, lines 56-64). Debry ['521] does not disclose transmitting the public key over the network to the registration server. However, Debry ['728] discloses a printer sending a request with the printer's public key to the file server (col. 13, lines 49-53, col. 13, line 65-col. 14, line 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Debry ['728] to send the public key to the registration server so that the server can use the public key to encrypt the file that only the printer has the secret key to decrypt for a more secure data transmission.

12. In respect to claim 5, Debry ['521] discloses the network registration protocol according to claim 4. Debry ['521] further discloses the step of "testing the received

secret unique identifier and public unique identifier in the remote registration server to verify the identity of the printer (see col. 8, line 65-col. 9, line 14).

13. In respect to claim 6, Debry ['521] discloses the network registration protocol according to claim 5. Debry ['521] further discloses "said printer obtaining said registration server's certificate, authenticating it with reference to a certificate authority, using a public key-exchange key in said certificate to exchange a secret session key with the server, and then use said secret session key to encrypt said transmission (see col. 9, lines 15-34).

14. In respect to claim 7, Debry ['521] discloses the network registration protocol according to claim 6. Debry ['521] further discloses " in the event the printer's identity is verified, of creating and signing a certificate containing said printer's public unique identifier and public signature key, in said server; and storing the printer's certificate in a database for retrieval by third parties wishing to exchange data with the printer" (see col. 6, lines 52-64, col. 5, line 65-col. 6, line 12).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Keronen et al. discloses a device and method for authenticating and certifying printed documents.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (703) 305-7690. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-9600.

Tongoc Tran
Art Unit: 2134

TT
September 22, 2003

Matthew B. Smithers
MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2134